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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,851	07/15/2003	Michael K. Barnoski	1125/204	2543
26588	7590	05/03/2007		
LIU & LIU 444 S. FLOWER STREET SUITE 1750 LOS ANGELES, CA 90071			EXAMINER LE, HUNG CHARLIE	
			ART UNIT 3663	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/620,851

Applicant(s)

BARNOSKI ET AL.

Examiner

Hung C. Le

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3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 5, 7 - 12, 14 - 24 is/are pending in the application.
- 4a) Of the above claim(s) 6, 13, 25 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 5, 7 - 12 is/are rejected.
- 7) ☒ Claim(s) 14 - 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                  |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                             | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>Various</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1 - 5, 7 - 12, 14 - 24 (Claims 6, 13, 25 - 28 were withdrawn by applicant) have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 5, 7- 10 are rejected under 35 U.S.C. 102(b) as being anticipated by F. Deni et al. (3,461,762).

With respect to claim 1:

F. Deni et al. disclose: An apparatus for producing parts, comprising:  
a tool (Fig. 1) comprising complementary punch (30) and die (17);  
a die holder (22) for supporting the die (17);

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a punch guide (upper part of Fig. 1) having a shaft (33) for guiding the punch (30) in relation to the die (17), wherein the shaft (33) is sized and shaped to receive the punch (30) in slidable contact, and wherein the punch (30) and the shaft (33) have flat sliding contact surfaces in a sliding direction; and

an interface (29) capable of mechanically interfacing force from a press with the punch (30), wherein the punch (30) is structurally decoupled from the press (Figs. 1 & 2).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

With respect to claim 2:

F. Deni et al. further disclose: wherein the die holder (22) includes a pocket (20) for nesting the mating surface of the die (17) in confronting orientation with the mating surface of the punch (30).

With respect to claim 3:

F. Deni et al. further disclose: a backup plate (23') attachable to the die holder (22) over the pocket (20) for securing the die (17) within the pocket (See Fig. 1).

With respect to claim 4:

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F. Deni et al. further disclose: a spacer (12) disposed between the die holder (22) and the punch guide, such that a workspace is defined between the die holder (22) and punch guide where the punch (30) engages with the die (17) to produce the part (See Fig. 1).

With respect to claim 5:

F. Deni et al. further disclose: wherein the punch guide (30), the die holder (22) and the spacer (12) are provided as a unitary structure (See Fig. 1).

With respect to claim 7:

F. Deni et al. further disclose: a stop (43) disposed between the press and the Punch (30), along a stroke path of the press, for limiting the translation of the punch (30) through the shaft (33, Fig. 1).

With respect to claim 8:

F. Deni et al. further disclose: a stop (40) disposed along a stroke path of the punch (30), for limiting the translation of the punch (30) through the shaft (33, Fig. 1).

With respect to claim 9:

F. Deni et al. further disclose: wherein the punch (30) includes a catch (39) adapted to engage the stop (40), such that when the catch (39) engages the stop (40), the stop limits further translation of the punch (30) towards the die (17, Figs. 1 & 2).

With respect to claim 10:

F. Deni et al. further disclose: biasing means (31) coupled to the punch (30), the Biasing means being biased when the punch (30) translates towards the die (17) under the force of the press, the biasing means being capable of moving the punch (30) away from the die (17) when the force is removed (Fig. 2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over F. Deni et al. (3,461,762) in view of Schroth et al.(6,311,597).  
F. Deni et al. disclose applicant's claim limitations except for a press having a press bed and a press ram, a ball attached to the punch and a socket attached to the press ram which are taught by Schroth et al. (Fig. 2).

With respect to claims 11 & 12:

F Deni et al. disclose: A system for producing parts, comprising:

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each stamping station comprising: a die holder (22) for supporting the die (17); a punch guide having a shaft (33) for guiding the punch (30) relative to the die (17), wherein the shaft is sized and shaped to receive the punch (30) in slidable contact, and wherein the punch (30) and the shaft (33) have flat sliding contact surfaces in a sliding direction; and

an interface (29) capable of mechanically coupling force from the press ram with the punch (30), wherein the punch (30) is structurally decoupled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time The invention was made to modify the apparatus as disclosed by F. Deni. Et al., by The teaching of Schroth et al. in order to have a self-guiding punch assembly and Die assembly, eliminating stack-up of the tolerances associated with cooperative assemblies and substantially reducing misalignment during stamping (Schroth et al.: Col. 4, lines 21+)

6. The statements of intended use or field of use, e.g., "for producing, wherein, capable of, for limiting, being capable of, supplying, for controlling, adapted to, etc..." clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference.
- See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ

458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

7. Claims 14 – 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in



this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung C. Le whose telephone number is 571-272-8757. The examiner can normally be reached on M-F: 07:30am - 05:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

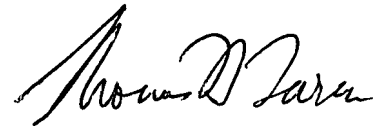
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HCL  
04/29/07



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